

### **REMARKS**

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 21-48, the only claims pending and currently under examination in this application.

#### ***Formal Matters***

Claims 21, 26 and 37 have been amended to recite specific operations by the apparatus when an error or no error is detected by the sensor. Support for this amendment may be found in the Claims as originally filed, in Claim 25 and in the specification at page 5, paragraph 33.

Claim 25 has been amended to delete subject matter added to Claim 21.

Claim 31 has been amended to change its dependency to Claim 21.

Claims 40 and 44 have been amended to specify a "computer readable magnetic, optical or solid state storage device". Support for this amendment may be found in the specification at page 5, paragraph 31.

#### ***Claim Rejections - 35 U.S.C. § 101***

Claims 21-24 and 26-37 and 39-48 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

United States Code 35 § 101 enumerates four categories of patentable subject matter - process, machine, manufacture, or composition of matter. The question of whether a claim encompasses enumerated statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to, but rather on the essential characteristics of the subject matter, in particular, its practical utility. MPEP §2106, IV, B.

With regard to Claims 21-24, 26-37 and 39, the Examiner asserts that the instant claims are embodiments of a computational method and that the Claims are drawn to an apparatus that "performs a method that derives a corrected drive pattern upon sensing

an error”, but does not necessarily require a tangible result. (Office Action dated February 6, 2009, page 2, item 3).

While not conceding to the veracity of the rejection, and solely to expedite prosecution of the instant application, Claims 21, 26 and 37 have been amended to recite specific operations by the apparatus when an error or no error are detected by the sensor.

Specifically, when no error is detected by the sensor, the apparatus operates in accordance with a target drive pattern based on nominal operating parameters to provide probes on the substrate in the target array pattern. When an error is detected by the sensor, the apparatus derives, based on the error, a corrected drive pattern and further operates in accordance with the corrected drive pattern to produce an array with probes on a substrate in the corrected array pattern.

Applicants submit that Claims 21-24, 26-37 and 39 involve a physical transformation and produce a useful, tangible and concrete final result.

With regard to Claims 40-45, the Examiner asserts that computer readable storage medium “may encompass carrier waves or electromagnetic signals, which are non-statutory *per se*”.

While not conceding to the veracity of the rejection and solely to expedite prosecution of the instant application, Claims 40-45 have been amended to specify a “computer readable magnetic, optical or solid-state storage device”. As such, Claims 40-45 are drawn to at least one of the enumerated categories of statutory subject matter.

Applicants submit that the claimed invention is directed to statutory subject matter under 35 U.S.C. § 101. Accordingly, withdrawal of this rejection is respectfully requested.

#### ***Claim Rejections - 35 U.S.C. § 102(a)***

Claims 38 is rejected under 35 U.S.C. § 102(a) as being allegedly anticipated by Blanchard et al. (WO 98/41531). Specifically, the Office alleges that Blanchard et al. teach “an apparatus with a dispensing head and a transport system wherein the drive

pattern controls the operation of the transport system and the operating parameter is the position of the substrate or dispensing head and the sensor views the substrate or dispensing head" which anticipates the claimed invention.

For a rejection of claims under §102 to be properly founded, the Office must establish that a single prior art reference either expressly or inherently discloses each and every element of the claimed invention. *See, e.g. Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In *Scripps Clinic & Research Found. v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991), the Federal Circuit held that:

"Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference.... There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Id.* at 1010.

Anticipation cannot be found, therefore, unless a cited reference discloses all of the elements, features or limitations of the presently claimed invention. In view of the remarks made herein, this rejection is respectfully traversed.

An element of the claimed invention is "a sensor to sense the position of the at least one fiducial mark on the dispensing head". As argued in the response filed on June 6, 2008, Applicants submit that the Blanchard et al., rather than teaching sensing a fiducial mark on the dispensing head, teaches sensing one or more marks on the substrate. There is no disclosure in Blanchard of a sensor to sense the position of at least one fiducial mark on the dispensing head. Indeed, the sensor taught by Blanchard is positioned in the apparatus such that it cannot view the dispensing head.

Applicants note that the Examiner came to the same conclusion as Applicants in the Office Action dated August 18, 2008. On page 6, third full paragraph of the August 18, 2008 Office Action, the Examiner cited the same section of Blanchard et al. as cited in the present Office Action (pages 62-64 and 75-76) and states that "the operating

parameter is the position of the substrate and the sensor views the substrate". Importantly, in the first full paragraph on the same page of the August 18, 2008 Office Action, the Examiner explicitly states that Blanchard et al. "does not teach where the sensor views a dispensing head" (in full agreement with our arguments).

Based on this conclusion, the Examiner withdrew the previous rejection of Claim 38 as being anticipated by Blanchard et al. (Office action dated August 19, 2008, page 7, item 7), affirming that Blanchard alone does not teach each and every element of the claimed invention.

In view of the above, Applicants respectfully request withdrawal of this rejection.

**CONCLUSION**

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 327-3400.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order no. 10990641-2.

Respectfully submitted,

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